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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 10/607,651 | 06/27/2003 | Theodore Kenneth Tezak | 41989.001 | 2640 |

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Intellectual Property Department
DEWITT ROSS & STEVENS S.C.
US Bank Building
8000 Excelsior Drive Suite 401
Madison, WI 53717-1914

EXAMINER

WILKENS, JANET MARIE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3637

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------|--|-------------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/607,651 | | TEZAK, THEODORE KENNITH | |
| | Examiner | | Art Unit | |
| | Janet M. Wilkens | | 3637 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 04 January 2005.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1 and 3-22 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1,3-8,11-13,15,16,18-20 and 22 is/are rejected.

7) ☒ Claim(s) 9,10,14,17 and 21 is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is indefinite for claims 3, 4 and 7 to depend from a canceled claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 11, 12, 15, 16, 18-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eiler in view of Duarte. Eiler teaches a tire used in combination with a speaker cabinet/enclosure (see Fig. 1). For claims 1, 15 and 19, Eiler fails to teach a shelving unit inside the tire. Duarte teaches a round cabinet with transparent shelves therein (see Fig. 1), a transparent front panel (see Fig. 1), side walls (side portions of the cabinet), and a removable back panel (see Fig. 3) thereon (the outer rim of the back panel not being removable). Furthermore, portions of the shelf rest behind the tire sidewall. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the tire assembly of Eiler by inserting the

cabinet of Duarte therein (the dimensioning of the cabinet of Duarte naturally being made to correspond to the inside of the tire; see Attachment A), in place of the cabinet/enclosure presently inserted therein, depending on the intended use of the tire. The cabinets being functional equivalents; the tire providing a distinct aesthetic property to the speaker cabinet of Eiler and therefore, would provide the same benefit to the cabinet of Duarte. Note: Portions of the shelves would inherently be covered by the tire sidewalls when the cabinet of Duarte is inserted into the tire. Furthermore, it would have been an obvious design consideration to use just a portion of the tire in combination with shelving/cabinet, depending on personal preferences, for economic reasons, etc.

For claim 4, although it appears that the shelves of Duarte extend to the back panel and are attached to the side walls of the cabinet, it is unclear whether or not they are attached to the back panel; however, it would be obvious to add adhesive between the outer rim of the back panel and the shelves to secure these members to each other, to, along with the side walls, firmly hold the shelves in place.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eiler in view of Duarte as applied to claims 1-4, 11, 12, 15, 16, and 18-20 above, and further in view of Baus. As stated above, Eiler in view of Duarte teach the limitations of claim 1, including a shelving unit in a tire. For claim 13, Eiler in view of Duarte fails to teach lighting as part of the unit. Baus teach lighting as part of a cabinet (see Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the cabinet of Eiler in view of Duarte by adding lighting, such as is taught by Baus

therein (at the upper and/or bottom sections thereof), to provide a means to illuminate objects placed on the shelves, etc.

Allowable Subject Matter

Claims 9, 10, 14, 17 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 5-8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed January 4, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA, 1971).

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Eiler teaches a speaker cabinet /enclosure enhancement in the form of a tire. To use this enhancement for a different circular cabinet/enclosure, i.e. the shelving unit of Duante, being well within the knowledge of one skilled in the art. Aesthetic reasoning being a valid motivation (even being one of the motivations for the disclosed invention). Also, the support and strengthening properties of the tire/shelving of the disclosed invention are not part of the claimed invention. Furthermore, stating that the tire of Eiler would "destroy" the shelving unit aesthetics of Duante is not agreed with. The center of the shelves still being one of the major focal points and having the end portions of the shelves obstructed not being a deterrent for using the structures of Eiler and Duante together, these portions, providing "hidden" storage for articles (not unlike that found by the disclosed invention).

Final note; even though a copy of the website printout has been received, the IDS still fails to comply with 37 CFR 1.97(d) because it lacks the fee set forth in 37 CFR 1.17(p). The printout has been placed in the application file, but the information referred to therein has not been considered.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

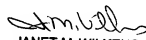
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet M. Wilkens whose telephone number is (703) 308-2204. (Starting April 8, 2005: (571) 272-6869) The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (703) 308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wilkens
March 30, 2005


JANET M. WILKENS
PRIMARY EXAMINER
Art 3637